REMARKS/ARGUMENTS

In view of the remarks herein, favorable reconsideration and allowance of this application are respectfully requested. Claims 21 and 23 are pending for further examination.

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Martin et al. (U.S. Patent No. 5,355,302), in view of Wilder (U.S. Patent No. 5,408,417), Banks et al. (U.S. Patent No. 5,559,714), and Alavi (U.S. Patent No. 5,970,467). This four-way Section 103 rejection is respectfully traversed for at least the following reasons.

Applicant incorporates by reference the previous remarks and arguments made in the 11/26/2008 Preliminary Amendment, as the claims continue to define over the prior art of record for substantially the same reasons indicated therein.

Applicant is concerned that certain errors have been made in resolving the scope and content of the prior art, which errors have led to the erroneous four-way combination of references by virtue of a hindsight reconstruction of the claims.

For example, the alleged Martin/Wilder/Banks three-way combination does not teach or suggest displaying a questionnaire when a particular predetermined song is selected. Indeed, Banks discloses that the questionnaire including marketing and consumer information questions is displayed while the personalized product purchased by the customer is being prepared. If such a teaching were applied to the alleged Martin/Wilder combination, the questionnaire would be displayed while the user was choosing from among the available songs. However, such a solution clearly is different from that which is specifically claimed in the above-recited claim. In particular, displaying a questionnaire while a user is selecting from available songs simply is not the same as triggering the display of a questionnaire after a particular selection is made, as

explicitly called for in the claims. It simply was not known for jukeboxes to give out awards for filling out questionnaires in this or other ways.

Alavi has been introduced in combination with the first three references in an attempt to make up for this deficiency. Newly cited Alavi discloses a computer that disseminates questions that can be answered by a responder who keys in an answer by use of a keyboard or mouse as detailed in lines 21 to 24 of column 1 of the summary of the document. However, like the previously cited documents, Alavi does not disclose a display of the questionnaire to be triggered after a particular selection is made. Moreover, Alavi does not disclose giving out an award for filling out a questionnaire as called for in claim 21. Alavi thus fails to make up for the deficiencies with respect to the prior three-way rejection. Thus, even the new four-way Section 103 rejection fails to teach or suggest each and every feature of claim 1.

Furthermore, the Office Action does not appear to have articulated a reasoning as to why the invention would have been obvious to one of ordinary skill in the art at the time of the invention. Indeed, the conclusory statement that introducing Alavi "for the benefit of providing incentive[s] to users to fully complete presented surveys" appears to have been drawn from Applicant's own invention as opposed to any teachings of the prior art references, misrepresents the objective teachings of the cited prior art, and attempts to support the legal question solely by reference dubious alleged "facts." Applicant respectfully submits that this hindsight reconstruction of the claims is impermissible under the strictures of *KSR*. Thus, even if the alleged four-way combination of references disclosed each and every feature of Applicant's claimed invention (which, as shown above, it does not), the USPTO still would not have met its burden of presenting a prima facie case of obviousness.

Accordingly, reconsideration and withdrawal of the outstanding Section 103 rejection is respectfully requested.

In view of the foregoing remarks, withdrawal of the rejections and allowance of this application are earnestly solicited. Should the Examiner have any questions regarding this application, or deem that any formalities need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: (#41,426)
Joseph S. Presta
Reg. No. 35,329

JSP/JR:lmj
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100